

Remarks

Reconsideration of the present application in view of the following remarks is respectfully requested.

Claims 1 to 51 are presently pending. Claims 10 to 51 are withdrawn as a result of being a non-elected invention. Claim 1 is to correct a typographical error. Applicant hereby reserves the right to pursue all such claims as originally presented, or claims of a similar scope, in a related application. The amendments to the claims are supported by the claims as filed and in the specification.

Discussion of the 103(a) Rejections

Claims 1 to 3 and 6 to 9 are rejected under 35 U.S.C. § 103(a) as allegedly obvious in view of U.S. Patent No. 5,344,483 to Hinton et al. (the '483 patent). Applicant respectfully traverses this rejection. In summary, one of ordinary skill in the art at the time of the present invention, would find no suggestion in the disclosure of the '483 patent of the subject matter now being claimed.

To establish a *prima facie* case of obviousness, "there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant." *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). "In other words, the examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

Applicant submits respectfully that one skilled in the art would not have been motivated to modify the teachings of the '483 patent in such a way as to obtain Applicant's claimed invention. The present claims define a method of forming an ink-jettable composition. The methods as now claimed require: (a) providing a viscous printing composition characterized in that has a **Brookfield viscosity in excess of 100 cps** at 25°C and is **suitable for application to a substrate using an impact printing technique**; and (b) adding to said viscous printing composition a diluent under conditions and in an amount effective to produce an ink-jettable composition, said diluent comprising: (i) at least one surface tension modifier; and (ii) optionally a solvent. In contrast, the '483 patent is directed to methods of replacing fatty acid bases with fatty acid ester bases which are the reaction product of the fatty acid and the dye in ink jettable compositions (see Col. 1, lines 47 to 53 and lines 65 to 68, Col. 2, lines 1 to 22).

The '483 patent discloses a method of making an ink-jetable composition comprising (a) forming a mixture of fatty acid which is liquid at room temperature, a polyalkylene glycol, and a dye capable of reacting with the fatty acid to form an ester, (b) heating the resulting mixture to a temperature sufficient to cause the dye and fatty acid to react to form the ester and for a time sufficient to drive off excess water from the mixture, and (c) combining the mixture with a diluent having a viscosity of about 10 cps or less to form the ink composition having an operating viscosity of less than 15 cps (see Col. 3, lines 63 to 68, Col. 4, lines 1 to 5, lines 20 to 25 and lines 62 to 66). The '483 patent **does not** contain any teaching or suggestion that the composition produced by steps (a) and (b) is of a certain viscosity or is "suitable for application to a substrate using an impact printing technique". The '483 patent also **does not** contain any suggestion to modify the process disclosed therein in such a way as to convert viscous printing compositions to ink-jetable printing compositions or address the problem of printing compositions suitable for particular applications using particular printing devices. Further, the Action **does not** provide any evidence to support the contention that the '483 patent contains any such disclosure or any suggestion to modify same. Accordingly, the presently claimed invention is patentable over the '483 patent for at least this reason.

Claims 4 and 5 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over the combination of the '483 patent and U.S. Patent No. 5,897,694 to Woolf (the '694 patent). Applicant respectfully traverses this rejection. One of ordinary skill in the art at the time of the present invention, when presented with the disclosures of the '483 and '694 patents, would not find any suggestion of the subject matter being presently claimed. As detailed above, the '483 patent **does not** teach or suggest that the composition produced by steps (a) and (b) is of a certain viscosity or is "suitable for application to a substrate using an impact printing technique". The '483 patent also **does not** contain any suggestion to modify the process disclosed therein in such a way as to convert viscous printing compositions to ink-jetable printing compositions or address the problem of printing compositions being limited to particular applications using particular printing devices. The '694 patent is cited by the Examiner because it allegedly teaches the addition of water and other additives to such compositions. However, the disclosure of the '694 patent, like the '483 patent, also fails to suggest the viscosity for impact printing suitability. As such, the presently claimed invention is patentable over combination of the '483 and '694 patents for at least this reason.

Conclusion

In view of the foregoing remarks, applicants assert that the present claims are in condition for allowance and respectfully request that the Office issue a Notice of Allowance at the earliest possible date. The Office is invited to contact Applicants' undersigned counsel by telephone in order to further the prosecution of this case in any way.

It is hereby requested that the term to respond to the Action of February 22, 2007 be extended one (1) month, from May 22, 2007 to June 22, 2007. Authorization to charge a Credit Card is given to cover the extension fee. The Commissioner is hereby authorized to charge any additional fees associated with this communication to Deposit Account No. 19-5425.

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Respectfully submitted,

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